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Applicant : Hsuan-Yin Lan-Hargest et al. Art Unit : 1617
Serial No. : 09/812,945 Examiner : M. Bahar
Filed : March 27, 2001
Title : HISTONE DEACETYLASE INHIBITORS

Commissioner for Patents
Washington, D.C. 20231

RESPONSE

In response to the action mailed November 6, 2001 ("Office Action"), Applicants submit the following remarks.

REMARKS

Claims 1-66 are pending. Claim 1 is independent.

Applicants affirm election of Group I, claims 1-66, for prosecution in this application. This election is made with traverse. Applicants respectfully note that at least Group I and Group II (claims 47-53) should be combined. Both groups are drawn to methods of inhibiting histone deacetylase in cells. Both groups are classified in class 514, subclass 575+. Applicants believe the scope of the search required to examine Group I and Group II covers the same material. Applicants respectfully request reconsideration of this aspect of the restriction.

Applicants affirm election of the compound 7-phenyl-2,4,6-heptatrienoylhydroxamic acid and the disorder of cancer for examination. Claims 3, 8-9, 11, 13, 16, and 19-39 have been withdrawn as being drawn to non-elected species. Applicants respectfully request that claims 21 and 22 be grouped with the claims 1, 2, 4-7, 10, 12, 17-18 and 40-46.

Rejection under 35 U.S.C. § 101

Claims 1, 2, 4-7, 10, 12, 17-18 and 40-46 have been rejected under 35 U.S.C. § 101 as follows:

because the claimed invention is not supported by a well established utility.

Claims 1, 2, 4-7, 10, 12, 17-18 and 40-46 were also rejected under 35 U.S.C. 112, first paragraph. Specifically, the claimed invention is not supported by either a *** [sic] asserted utility or a well established utility for the reasons set forth above (page 4 of the Office Action).

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